

REMARKS

In an Office Action mailed April 26, 2006, claims 27, 28 and 30 were rejected under 35 U.S.C. §102(e) as being anticipated by Abreu (U.S. Patent No. 6,423,001). Objections were made to Applicant's traversal of the prior restriction requirement and election of claims, to the Information Disclosure Statement filed March 10, 2004 ("the 2004 IDS") and to the drawings. Applicant respectfully traverses and requests reconsideration.

As an initial matter, Applicant gratefully acknowledges the courtesies extended by Examiner to Applicant's representative during the telephone conferences of August 28 & 29, 2006. In those telephone conferences, Examiner and Applicant's representative discussed the objections to the IDS and to Applicant's traversal of the restriction requirement and subsequent election of claims. Applicant's summary of those telephone conferences are set forth below. Examiner is invited to contact the undersigned representative if it is believed that any portion of the summary below misstates or otherwise fails to accurately reflect the content of the telephone conferences.

In the objection to the IDS, Examiner stated that the 2004 IDS, , contrary to 37 C.F.R. § 1.98(a)(2), failed to provide copies of the references cited therein. During the telephone conference of August 28, 2006, Examiner's attention was drawn to the citation in the 2004 IDS to 37 C.F.R. § 1.98(d), which states in relevant part that "A copy of any [reference] listed in an information disclosure statement is required to be provided, even if the [reference] was previously submitted to, or cited by, the Office in an earlier application, unless: (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section." In light of this, Applicant's representative and Examiner agreed that the 2004 IDS properly

complied with Rule 1.98(d). Examiner agreed to refer to the parent application file to determine which references, if any, cited in the 2004 IDS might still be required. Thereafter, during the telephone conference of August 29, 2006, Examiner informed Applicant's representative that all of the cited references had been properly provided, with the exception of the following references (as identified using the indexing notation from the 2004 IDS): A224-A226 and A228-A230. A further IDS is being submitted herewith providing copies of these missing references.

Regarding the objection to Applicant's traversal of the restriction requirement and subsequent election, Examiner objected to Applicant's election of Species VII (corresponding to FIG. 15) and designation of claims 1-10 and 23-26 as reading on the elected species. During the telephone conference of August 28, 2006, Applicant's representative noted that FIG. 15 (alleged Species VII) was actually a specific example of the more generic embodiment illustrated in FIG. 11. In support of this, Applicant's representative noted the teachings of paragraph [0074], first and last sentences of the instant specification to demonstrate that FIG. 15 (notwithstanding its failure to show a return electrode for ease of illustration) is in fact a specific example of the generic embodiment of FIG. 11. For this reason, Applicant respectfully submits that claims 1-10 and 23-26 read on the generic embodiment of FIG. 11. In a similar vein, Applicant's representative noted that Species X and XI (corresponding to FIGs. 18 and 19, respectively) were likewise specific examples of the generic embodiment of FIG. 12. Examiner acknowledged the existence of the generic illustrations and that the claims selected for examination by Examiner in the instant Office Action (claims 27, 28 and 30) were overly restricted. As such, Examiner agreed to vacate the withdrawal of claims 1-26, 29 and 31-39. For this reason, the listing of the claims above indicates that claims 11-22 and 27-39 have been withdrawn, in keeping with Applicants previous election of claims 1-10 and 23-26.

In light of the above, Applicant believes that claims 1-10 and 23-26 may be examined together to the extent that these claims all relate to at least one stimulating electrode being placed on a surface structure of the eyeball and at least one electrode being placed substantially distant from the eyeball. Likewise, claims 11-22 and 27-39 may be examined together to the extent that these claims all relate to at least one stimulating electrode being placed on a first surface structure of the eyeball and at least one electrode being placed on a second surface structure of the eyeball. Furthermore, to the extent that the present invention discloses two closely related generic embodiments (each encompassing multiple related sub-species), rather than the 11 unrelated species as originally proposed, Applicant respectfully submits that Examination of the two generic embodiments should not place an undue burden on Examiner.

Regarding the objections to the drawings, Applicant notes that corrected, formal drawings are being submitted herewith. Applicant believes these corrected, formal drawings address the deficiencies cited by Examiner. As a result, Applicant respectfully submits that the corrected, formal drawings are now in condition to support allowance.

Referring now to the substantive rejection, claims 27, 28 and 30 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Abreu. In light of the above, Applicant's remarks below concerning the teachings of Abreu are not limited to claims 27, 28 and 30. Generally, Abreu teaches methods and apparatus for "for the measurement of intraocular pressure and eye hydrodynamics." (col. 7, lines 4-5) That is, to the extent that Abreu provides any enabling disclosure for the methods and devices taught therein, it is limited to devices that serve to detect conditions of the eye. To this end, Abreu teaches various contact lens-like devices that may be used for the *measurement* of various eye-related parameters, e.g., FIG. 38A (col. 92, lines 23-45: describing an annular "contact device" for surrounding the cornea and comprising a *sensor* 744),

FIG. 59B (col. 94, lines 63-65: illustrating a surgically implanted embodiment *without* electrodes) and FIG. 59C (col. 94, line 66 – col. 94, line 4: describing an externally placed contact device including electrode 986 for *producing* a microcurrent, i.e., in a sensor configuration). Abreu does mention, at col. 20, lines 30-45, the possibility of using “electrodes . . . surgically implanted or externally placed on the eye . . . to electrically stimulate non-functioning neural or degenerated neural tissues in order to treat patients with retinal degeneration.”

Applicant notes that claims 1-10 and 23-26 are directed to embodiments in which a stimulating electrode is provided on a surface structure of an eye and in which a return electrode is provided on “conductive biological tissue substantially distant from the eyeball.” Applicant notes that Abreu fails to describe anything even remotely akin to a return electrode provided on conductive biological tissue substantially distant from an eyeball. For this reason, Applicant respectfully submits that claims 1-10 and 23-26 are not anticipated by Abreu and are instead in suitable condition for allowance.


To the extent that Abreu teaches embodiments in which electrodes are placed externally on the eye, Abreu’s further teachings at col. 20, lines 30-45 do suggest the possibility of using such externally placed electrodes for electrical stimulation. However, Applicant disputes any assertion that Abreu operates as an effective reference for the electrical stimulation of an internal surface structure of the eye. In particular, Applicant respectfully submits that the disclosure of Abreu regarding electrical stimulation of an eye fails to recite anything regarding electrical stimulation of an internal surface structure of an eye. Thus, for example, Abreu fails to anticipate non-elected claims 16, 18, 29 and 31, each of which recite the use of electrodes provided on an internal surface structure of the eye.

In light of the foregoing comments, Applicants respectfully submit that the instant application is in condition for allowance and request that a timely Notice of Allowance be issued in due course.

Respectfully submitted,

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